

## **REMARKS**

In light of the remarks below, reconsideration and allowance of this application are respectfully requested.

Claims 1-61 were rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al. (Downing) (US Patent 5,963,647) in view of Risafi et al. (Risafi) (US Patent 6,473,500) and further in view of Tedesco et al. (Tedesco) (US Patent 6,085,888). Applicant respectfully traverses this rejection for the reasons discussed below.

### **The Downing Patent**

The Downing patent pertains to transferring funds from a customer to a recipient by first depositing by the customer a sum of money to a money-transfer company. The customer then supplies (e.g., via telephone) the recipient with a secret code or password to enable the recipient to access the funds. (col. 5, lines 16-18; col. 7, lines 6-17). The recipient uses a terminal, such as a Customer Activated Terminal (CAT, which is a special type of automated terminal machine – ATM) to enter the secret code (i.e., the password supplied by the customer to the recipient), along with the recipient's name to obtain the money deposited by the customer (col. 7, lines 29-41).

The Downing patent presents the above-summarized process as a money-transfer solution that enables “cardless withdrawal” by customers and non-customers, as set forth on col. 3, lines 40-47. Indeed, problems encountered by prior art processes as disclosed in the Downing patent and which are stated as being overcome

by the Downing patent invention are: (1) the problem of requiring “a recipient to locate an office which is open and which is capable of receiving transfers;” and (in other prior art systems) (2) the problem of having “a card or equivalent means which permits the recipient to access an ATM or equivalent terminal” (col. 3, lines 1-13), where the problems encountered with attempting to utilize ATM cards in various foreign countries is discussed in the Background section of this patent. The Downing patent proposes a process that expressly does not use an ATM card or equivalent to withdraw money from an automated machine.

Hence, one of ordinary skill in the art reading the Downing patent would be taught away from any modification that incorporates the utilization of ATM-like cards and, further, that requires the recipient to go to an open office to facilitate the money transfer. The present invention, on the other hand, employs a device, such as an ATM card, and further employs the utilization of distributors that activate such a device before providing it to the recipient who then can withdraw money at an automated machine using the activated device. Thus, without even considering either the Risafi or Tedesco patents cited by the Examiner, the teachings of the Downing patent strongly support the position that it would not have been obvious to one of ordinary skill in the art to modify the invention disclosed in the Downing patent to produce applicant’s claimed invention.

#### The Risafi Patent

The Risafi patent was relied upon by the Examiner to disclose, among other things, that a card can be used to transfer money, that issuers or agents can sell or

distribute cards to card users, and that the cards can be acquired for the purpose of withdrawing cash (Office Action, page 4, lines 1-9).

More particularly, the Risafi Patent discloses a system and method for using a prepaid card in which a consumer interacts with an agent distributing cards, the consumer selects a PIN, the card is then activated and the consumer may use it at a money-dispensing terminal. (col. 3, line 54 – col. 4, line 16). The consumer, that is, the individual purchasing the prepaid card, is able to purchase such a card from agents and distributors (col. 6, lines 48-51; col. 10, lines 1-16).

With respect to employing the disclosed prepaid card for transferring money from a sender to a beneficiary, Risafi, in col. 9, lines 51-57 recites,

“The card can also be used to transfer money, much as a wire transfer is accomplished today. A transferor adds value to a card account, and a second card having access to the same account is delivered to the transferee, perhaps in a different country. After the transferee learns of the PIN from the transferor, the transferee is then also able to access the value in the card account.”

This discussion in Risafi is further described in col. 19, lines 28-45, which recites,

“A fourth application is using a prepaid card for transferring money from a sender to a beneficiary. In this application, a money transfer card is sold by prepaid card issuers or their agents in the sender's country, where the sender adds value to the card account. Another card is delivered to the beneficiary, who is likely in a different country, and who is able to make withdrawals at ATMs or purchases at POS terminals. As illustrated in FIG. 10c, in step. 1072, the sender purchases card 100 as described in FIG. 4. Alternatively, if the sender already owns a card, the sender can reload the current card's account with the amount of value to be transferred. In step 1074, the sender selects a PIN, and, in step 1076, agent terminal 402 via PDC 404 activates the card. In step 1078, a second card that is able to access the sender's card account is delivered to the beneficiary. The beneficiary, in step 1080, uses

the card, and, in step 1082, the sender can reload the card account, allowing the beneficiary to continue making purchases and cash withdrawals.”

Thus, Risafi describes transferring money from a customer to a beneficiary by arranging for a second card to be used by the beneficiary, where such second card operates identically to the first card. Hence, the card to be utilized by the recipient is activated before the beneficiary is involved in the process. With reference to Fig. 10C of the Risafi patent, the sender (customer) purchases the card and selects the pin in steps 1072 and 1074, respectively, and then the card is activated in step 1076. Next, in step 1078, a second card is delivered to a beneficiary and the beneficiary then uses the card in step 1080. The last disclosed step 1082 pertains to the sender reloading the card so that the recipient (beneficiary) can withdraw more money by using the second card already in the recipient’s possession.

#### The Tedesco Patent

The Tedesco patent was relied upon by the Examiner for disclosing “establishing and managing vending machines in which items may be purchased from a vending machine by entering an identification code (column 4, lines 13-28).” (Office Action, page 4, lines 10-12).

More specifically, the Tedesco patent relates to utilizing a vending machine to dispense items to consumers that have a subscription for such items. The invention of Tedesco addresses the disadvantage of “the loss of a sale to a regular customer who would make a purchase [from the vending machine] but for an immediate shortage of

cash." (col. 2, lines 35-36). Col. 2, lines 45-54 provides the general object of the

invention:

"A need therefore exists for a method and apparatus that provides consumers additional payment options for vending machine purchases. A need further exists for a method and apparatus that allows consumers who make frequent purchases at a vending machine to receive items without depositing currency or presenting a physical form of payment every time a customer requests a purchased item. A need also exists for a method and apparatus for more accurately and efficiently managing and predicting inventory of a vending machine."

Tedesco then describes utilizing a subscription process in which a consumer can have a subscription to goods that are dispensed by a vending machine, wherein entry of a redemption code (a "Pin") in the vending machine results in the good being dispensed, thus alleviating the need for the consumer from utilizing cash to purchase the good at the time of purchase.

**It Would Not Have Been Obvious to Combine the Teachings of Downing, Risafi and Tedesco to Produce The Claimed Invention**

For the reasons discussed below, it is submitted that it would not have been obvious to one of ordinary skill in the art to modify the Downing patent in the manner proposed by the Examiner.

First, it is submitted that one who reads and understands Downing and Risafi, with or without Tedesco, would be neither encouraged nor motivated to use Risafi's prepaid cards (or Risafi's disclosed steps of interacting with an agent that distributes cards) within the system and process described in Downing. If Downing discloses a process that explicitly seeks to not employ electronic cards that are used to withdraw money from an ATM (or similar automated machine), and Risafi explicitly pertains

solely to the implementation of an electronic card for various transactions, why would it be obvious to combine these two references? Fundamentally, these references have contradictory objectives and, therefore, one of ordinary skill in the art would be taught away from using the teachings in Risafi to modify the system/process disclosed in Downing.

It is further submitted that Tadesco provides no further incentive to one of ordinary skill in the art to combine the teachings of Downing with the teachings of Risafi. As mentioned above, Tadesco pertains to the use of a vending machine by subscribers to alleviate the need for those subscribers to use money at the time of purchasing something dispensed by the vending machine. Downing relates to cardless withdrawal of monetary funds, which is somewhat opposite to the purpose of Tadesco which seeks to allow consumers to obtain goods without using cash or a credit card and, thus, would neither motivate nor encourage one of ordinary skill in the art to combine these references. Tadesco also is quite dissimilar in its purpose to Risafi, which relates to using cards for accessing monetary funds. Hence, even taking Tadesco into account, one of ordinary skill in the art would neither be motivated nor encouraged to combine the teachings of the cited art in the manner proposed by the Examiner.

The Combination of Downing, Risafi and Tedesco Still Would NOT Produce Applicant's Claimed Invention

Notwithstanding the above-assertions that it would not have been obvious to combine the teachings of Downing, Risafi and Tedesco, it is further asserted that even

if the teachings of these three references somehow were combined, the results of such a combination still would not produce applicant's claimed invention since none of these references discloses various features claimed in the independent claims of the present application.

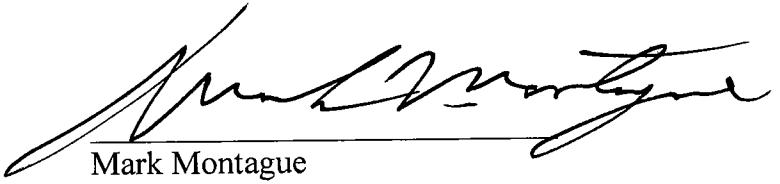
In particular, none of the references discloses, as recited in various independent claims, receiving by a beneficiary a money pick-up device from a distributor and having that money pick-up device activated by the distributor so that it may be used at a money-dispensing machine. Downing clearly does not disclose these features since it relates solely to cardless withdrawal. Risafi does not disclose these features since the purchaser of the pre-paid card (the consumer) actually obtains the money pick-up device (i.e., the ATM card) from a distributor (the agent) when the card is purchased. A beneficiary, in Risafi, can obtain a second card but, as mentioned above, activation occurs prior to the beneficiary's involvement and, moreover, Risafi is silent as to how the beneficiary obtains the second card. Risafi only states that "a second card having access to the same account is delivered to the transferee." (col. 9, lines 53-54; also col. 19, lines 41-43). Thus, Risafi does not teach receiving by a beneficiary a money pick-up device from a distributor and having that money pick-up device activated by the distributor. Finally, Tedesco likewise does not disclose these features since it does not disclose or suggest that a vending machine dispense a money pick-up device. While Tedesco provides for a vending machine that dispenses goods, it is submitted that the notion of a vending machine dispensing a money pickup device is completely contrary to the teachings of Tedesco, which

provides as its fundamental goal a process of employing subscriptions so that individuals need not utilize cash, a credit card or a bank card to obtain goods that can be dispensed by vending machines.

In view of the foregoing, it is respectfully submitted that the combination of Downing, Risafi and Tedesco for the purpose of rejecting claims 1-61 is not proper. Accordingly, it is requested that the rejection of the claims be withdrawn.

In light of the foregoing, reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,



Mark Montague  
Reg. No. 36,612

COWAN, LIEBOWITZ & LATMAN, P.C.  
1133 Avenue of the Americas  
New York, NY 10036-6799  
(212) 790-9200